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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91188736
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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ANASTASIA BEVERLY HILLS, INC.  
ANASTASIA SOARE  
ANASTASIA SKIN CARE, INC.  
Opposers,

v.

ANASTASIA MARIE LABORATORIES, INC.  
Applicant.

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) Opposition No.  
) 91188736  
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) APPLICANT'S REPLY  
) BRIEF TO OPPOSERS'  
) RESPONSE TO  
) APPLICANT'S CROSS-  
) MOTION FOR  
) SUMMARY JUDGMENT  
)  
)

Applicant, Anastasia Marie Laboratories, Inc., by and through its attorney, hereby submits its Reply to Opposers' Response to Applicant's Cross-Motion for Summary Judgment in the within matter. In support thereof, Applicant relies upon its Reply Memorandum of Law, Motion to Amend Counterclaims and Amended Counterclaims submitted concurrently herewith.

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## **I. PREFACE**

Opposers' brief consisting of rambling incoherencies, misstatements of law, empty excuses and irrelevant issues<sup>1</sup> fails to raise any genuine issue as to a material fact to overcome Applicant's Cross-Motion for Summary Judgment to cancel Opposers' Registrations 2,798,069 and 2,821,892 for "A Anastasia Beverly Hills" and "Anastasia Beverly Hills" in Class 3 ("the Marks") on the ground of fraud.

The undisputed facts are:

- (1) Opposers filed false verifications with the PTO to obtain registrations.
- (2) Opposers knew that the PTO verifications were false.
- (3) Opposers submitted the false verifications with intent to deceive the PTO.
- (4) The PTO issued registrations based upon Opposers' false verifications.

The legal issue is:

Whether Opposers' admissions of non-use and admitted conduct in submitting false verifications in 2 trademark applications over 2 years, viewed in light of the totality of the evidence, amounts to, at a minimum, reckless disregard of the truth rising to the level of fraudulent intent?

## **II. REPLY ARGUMENT**

### **A. Opposers' Challenge to Applicant's Amended Fraud Counterclaims**

While Applicant believes that its Amended Counterclaims plead fraud with particularity, out of an abundance of caution, Applicant has filed a second proposed Amended Counterclaim setting forth Applicant's fraud allegations in accordance with *DaimlerChrysler Corporation and Chrysler, LLC v. American Motors Corporation*, Cancellation No. 92045099 (January 14, 2010).

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<sup>1</sup> Opposers' arguments and exhibits discussing priority, dates of use, PTO databases, FDA cosmetic regulations, Opposers' salon customers and services, Applicant's president's given name, attorney-client privilege and usage of Applicant's mark are totally irrelevant to this Cross-Motion on claims of fraud and should not be considered.

**B. Under Bose, Evidence of Opposer's Intent to Deceive Can Be --- and Is --- Inferred from Statements and Circumstances.**

Opposers' remarks misapprehend *In re Bose*, 2009 WL 2709312 (Fed. Cir., Aug. 31, 2009) and settled law applied by *Bose*, which affirms that fraud can be proved by indirect and circumstantial evidence:

We understand the Board's emphasis on the "objective manifestations" to mean that 'intent must often be inferred from the circumstances and related statement made. *Id.* (internal quotation marks omitted quoting *First Int'l. Serv.*, 5 USPQ2d at 1636). We agree." (Emphasis added). *In re Bose*, *Id.*

The sole issue is whether Opposer's conduct, *viewed in light of the totality of the evidence of the related statements and circumstances*, amounts to a fraudulent intent? The undisputed facts are clear and convincing that it does.

Opposers filed 2 applications for 2 trademarks. They secured 2 registrations by signing 2 sworn Declarations, filed 2 years apart, that they used the Marks on 57 products when, in fact, they had not. Years later, in the face of fraud claims, Opposer Soare admits, in a sworn Declaration, that 13 goods listed in both registrations never existed. (Soare Decl., Exh. PB-1). She offers a potpourri of excuses:

- (1) The PTO Declarations which she signed did not make "any explicit reference to any specific goods...". (Soare Decl., Exh. PB-1, ¶ 15, 25).
- (2) She "did not conduct a careful review of the 'goods' listed" in either of the two applications. (Ibid., ¶15, 25).
- (3) She "did not have a clear understanding of what it means to 'use the mark in commerce' other than that the listing of goods included all the product categories that she was "planning to market". (Ibid., (¶15, 25).



- (4) She “did not realize that the 2001 ABH Amendment would be interpreted to mean that ABH was claiming that it was then using the mark in any particular way on any specific product....” (Ibid., ¶ 20).
- (5) She “mistakenly believed that any commercial use of the name ‘Anastasia Beverly Hills’ constituted ‘use in commerce’.” (Ibid., ¶ 21).
- (6) She “did not review the Notice of Allowance” referenced in the 2003 AABH Declaration which she signed under oath. (Ibid., ¶ 30).
- (7) She “did not know that the Statement of Use would be interpreted to mean that ABH was claiming that it was using the mark on each of those goods in interstate commerce.” (Ibid., ¶ 31).
- (8) She “did not understand the legal meaning of interstate commerce”. (Ibid., ¶ 31).
- (9) She “does not profess to be an expert on what constitutes normal trade usages and practices in the field of fragrances and perfumes.”(Id. (¶ 38).

If the foregoing facts do not constitute “reckless disregard” of the truth of her verifications, nothing would.

**C. The Circumstantial Evidence Fortifies the Finding of Fraud.**

Citing *Star Scientific, Inc. v. R.J. Reynolds Tobacco Co.*, 537 F. 3d 1357, 1366 (Fed. Cir. 2008), *Bose* specifically held that subjective intent to deceive can be inferred from indirect and circumstantial evidence that is “clear and convincing”. The court also stated, “When drawing an inference of intent, ‘the involved conduct, viewed in light of all the evidence....must indicate sufficient culpability to require a finding of intent to deceive.’ *Kingsdown*, 863 F.2d at 876.” *In re Bose, Id.*

In this case, the circumstantial evidence is clear and convincing and compels a finding of Opposer’s intent to deceive the PTO:

(1) **Opposer's Reckless Disregard Conduct Was Not Isolated but a Pattern of Conduct Over 2 Years; Infecting 2 PTO Applications.**

This is not a case of an Applicant who, in the course of the filing and prosecution of a single application, made a single error. This is not a case of an “honest mistake” or “mere inadvertence” involving an isolated incident where:

- a box was inadvertently checked on the TEAS form (*Medinol Ltd. v. Neuro Vasx, Inc.*, 67 U.S.P.Q.2d 1205 (T.T.A.B. 2003); or
- goods were inadvertently left in a box on the TEAS form (*Jimlar Corp. v. Montrexpert S.P.A., Canc. No. 92032471* (T.T.A.B. June 4, 2004, not citable as precedent); or
- an application was inadvertently not divided into “use-based” and “intent-to-use” (*J.E.M. International, Inc. v. Happy Rompers Creations Corp., Canc. No. 92043073* (TTAB February 10, 2005 not citable as precedent).

Instead, we have a pattern of reckless and reprehensible indifference as to the truth or falsity of PTO documents, perpetuated over 2 years, infecting 2 applications made with intent to procure registrations which had no basis in law or fact -- and which did, in fact, result in the issuance of registrations covering 57 different items in Class 3; for 13 of which Opposer now readily admits she has never used her marks.

The facts in *Bose* and cases pre-*Bose* which draw a finding of “no fraud” share a common thread: a party in “good faith” with a reasonable belief made an honest mistake. See *Maids to Order, Inc. v. Maid-to-Order, Inc.*, 78 USPQ 2d 1899 (TTAB 2006). Here, Opposer had no such reasonable belief, and she made no innocent mistake. Indeed, her intent and *lack* of “good faith” was crystal clear by her statements, her admitted pattern of conduct and her admissions of non-use: she plainly wanted broad registrations, and she intended to obtain them regardless of the law and despite non-use. In misleading the PTO with her false verifications, she accomplished her objective.



**(2) Opposer Soare's Press Releases Showcase Deceptive Intent**

Opposer Soare's own Disclosures belie her "honest mistakes" claim. The undisputed facts are that, when Opposer signed PTO verifications alleging use of the Marks in "1999" and "2000", she deceived the PTO --- as proven by her remarks to *Women's Wear Daily* and *The Wall Street Journal* in August and October, 2000.

In August and October, 2000, Opposer gave press interviews to publicize her new makeup and eyebrow products launch at Nordstrom. Aware that the media knew her only as the "Eyebrow Queen" Opposer told the press of her *hopes* and "*goals*" to expand her business to include skin care and fragrance in the future:

**(a) Opposer's August 2000 Interview with *Women's Wear Daily***

"Of the overall *goals* for the line, she admitted 'step two', *a full skin care collection, is underway*, as is step three, a fragrance. She already has begun the painstaking process of identifying scents, but *she's in no rush to bring out either category*". (Emph. added). WWD, August, 2000, (Opp. Discl. ABH 010023, App. Brief- **Exh.C**).

**(b) Opposer's Oct., 2000 interview with *The Wall Street Journal***

"This fall she launches the Nordstrom counters. *Next, she would like to launch a skin care line, followed by a fragrance. Eventually she dreams of taking her company public. 'If I want something, I will get it,' she says. I am the most ambitious person you have ever met.*" (Emph. added). WSJ, October 23, 2000, (Opp. Discl. ABH 010131, ABH 010132, ABH 010133, ABH 010134, App. Brief- **Exh.D**).

Opposer subsequently filed verifications with the PTO alleging "use" in 1999 and 2000 for skin care and fragrance products *which she had acknowledged to the press in 2000 did not exist*. Opposer knowingly misled the PTO into issuing registrations by claiming "use" of the Marks on goods which *she knew* was false.

Proof of intent to commit fraud cannot be more clear and convincing.



**(3) Opposers' Website Printouts in March, 2009 Show Non-Use**

Both parties' March, 2009 printouts of Opposers' website prove the undisputed fact of non-use of the skin care, fragrance and nail products listed in the registrations of both of the Marks; fortifying the circumstantial evidence of Opposers' fraud.

**(4) Opposer's Misstated Use Dates Are Telling.**

While incorrect use dates do not, alone, constitute fraud, in the totality of evidence in *this* case, Opposer's admission that she misstated all use dates is telling --- and totally consistent with the rest of Opposer's conduct in misleading the PTO to obtain registrations.

**D. Opposers' Exhibit DB-4 Underscores a Serial Pattern of Deception**

Still, today, Opposers try to mislead the PTO. This is astonishing.

Hoping that the PTO will not actually look at their *Exhibit DB-4*<sup>2</sup> (which they incorrectly reference as "*DB-2*"), Opposers make the specious claim that this 10 year old Exhibit "*documents an order for over 3500 items divided over 150 stock keeping units*" proving use "*on the majority*" of registered goods. (*Opp. Brief*, p. 10).

Opposers' claim is duplicitous. Opposers' registrations list 57 Class 3 goods. Their *Exhibit DB-4* lists (a) 2 skincare items; (b) no fragrance goods; (c) no nail goods; and (d) 16 makeup products multiplied by color shades ("lipstick" is listed 30 times by 30 color shades). Opposers' arithmetic "majority" is irrelevant to the letter and spirit of the trademark law and underscores Opposers' unremitting and unconscionable deceptive conduct with the PTO.

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<sup>2</sup> Exhibit DB-4 lists "After-Tweeze" Cream and "Pre-Tweeze" Gel whose stated functions pertain to eyebrow plucking. These 2 products are listed under "Brows" in Opposers' 2009 website and are the closest items to "skincare" *that exist* in their Exhibit DB-4. The "After-Tweeze" Cream is the only product which Opposers' declarant Baum mentions to justify his reference to "skin care products". Opposers' attempt to "stretch" this product's use to justify use of 29 skincare goods in their registrations is patently false, deceitful --- and absurd.

**E. Opposers' Claim that their Mistakes Are "Immaterial" Is Baseless,  
and their Motion to Amend Continues to Be Meritless.**

Opposers' claim that their listings of unused goods in their registrations is "immaterial" -- is factually ridiculous and legally incorrect. The fact that Opposers have been brandishing their fraudulently obtained registrations in an opposition proceeding is, itself, clear proof of their "materiality".

*Bose*, which changed the standard for determining fraud, leaves unchanged the legal principle outlined in cases pre-*Bose* concerning "materiality". Trademark law is indubitable that statements regarding the use of the mark on goods and services are absolutely material to issuance of a registration covering such goods and services. See *First International Services Corp. v. Chuckles Inc.*, 5 USPQ2d 1628 (TTAB 1988); *General Car and Truck Leasing Systems Inc. v. General Rent-A-Car, Inc.*, 17 USPQ2d 1398 (S.D. Fla. 1990), aff'g *General Rent-A-Car Inc. v. General Leaseways, Inc.*, Canc. No. 14, 870 (TTAB May 2, 1988).

See also *Medinol, Id.*:

There is no question that the statement of use would not have been accepted nor would registration have issued but for respondent's misrepresentation, since the USPTO will not issue a registration covering goods upon which the mark has not been used. (citations omitted).

And, *Esprit IP Limited v. Mellbeck Ltd.*, Opp., 91189412 (June 25, 2009), which is not precedential but is offered for its persuasive value :

By setting forth an identification of goods for more than fifty goods, when applicant was not using the mark on all of these goods, and indeed may have been actually using the mark only on one of those identified goods, applicant made a material misrepresentation of fact that the U.S. Patent and Trademark Office relied upon in determining applicant's right to a registration.

And, *Hachette Filipacchi Presse v. Elle Belle LLC*, Cancellation No. 92042991 (TTAB April 9, 2007):



Similarly, in this case there is no question that the application for registration under Section 1(a) of the Trademark Act would have been refused but for respondent's misrepresentation regarding its use of its mark on all the identified goods in the application. Respondent's contention that a registration would have issued nonetheless if the application listed only the limited description of women's clothing is irrelevant to our discussion.

Likewise, in this case, it is unquestioned that the registrations would not have issued but for Opposer's misleading statements to the PTO. Opposers' remarks as to "how" the registrations could have otherwise issued, and "what" they could have otherwise "done" are irrelevant. Opposers' registrations are not amendable to cure the fraud (*Medinol, Id., Zanella Ltd. v. Nordstrom, Inc.*, 90 USPQ2d 1758 (TTAB 2008). Opposers' Motion to Amend is meritless.

**F. Opposer Concedes (Again) Her Reckless Disregard.**

Conceding that her Declarations were "false and material", Opposer now claims (not surprisingly) that she "did not know" that they were (*Opp. Brief, p.13*).

**G. Opposer's Additional Excuses Fall Flat.**

In their zeal to address all bizarre lines of defense, Opposers declare war on themselves with the following excuses; all of which have no legal basis:

**(1) The "Foreign Speaking" Excuse.**

Opposer Soare, who has mastered the art of self-promotion and built an empire over which she reigns as the "Eyebrow Plucking Queen"; making guest-plucking appearances on nationally televised programs and giving articulated interviews to national publications --- would have this Board believe that her false and misleading statements to the PTO are the fault of a limited command of the English language upon arriving in California from Romania 21 years ago.

This excuse is inane. The language in the PTO documents is clear, unambiguous and straightforward. *Hachette Filipacchi Presse v. Elle Belle LLC, Id.* It



was not language problems that resulted in her signing the false declarations; it was her deliberate disregard for the truth.

**(2) The “My Law Firm Did It” Excuse.**

Not surprisingly, Opposers fire volleys of accusations at the New York and California law firms involved in the prosecution of Opposers’ applications; blaming those firms for the invalid registrations.<sup>3</sup> The law is unfazed.

Client and attorney both “share the duty” to avoid fraud, and the signer is held accountable for any false or misleading statements made therein. *Smith International, Inc. v. Olin Corp.* 209 USPQ 1033 at 1047 (TTAB 1981), *Hachette Filipacchi Presse v. Elle Belle LLC, Id.*, Cooper, Lunsford, McCarthy and Ropski, “Fraud in the Trademark Office: A TMR Panel”, 74 Trademark Reporter 50, 57-58 (Jan./Feb. 1984).

Should Opposers have issues with their previous lawyers, those issues are between them and their law firms and those firms’ insurance companies and not the Patent and Trademark Office and this Applicant.

**(3) The “I Am Not a Lawyer” Excuse.**

Claiming that their non-lawyer status shields them from a finding of fraud, Opposers ignore the ancient maxim that “ignorance of the law is no excuse”. Their claim finds no support under trademark law or *any* law. *Hurley International LLC v. Volta*, 82 USPQ2d 1339 (TTAB 2007).

**H. The Evidence of Opposers’ Fraud Remains Clear and Convincing.**

The burden was upon Opposers to establish the existence of disputed facts, to designate specific portions of the record, or show “.....an evidentiary conflict created

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<sup>3</sup> Casting themselves as mere puppets of the trademark Bar, Opposers engage in an incoherent and tortured diatribe on attorney-client privilege and semantic differences in usage of verb tense; the ostensible purpose of which is to avoid responsibility for their unsuccessful attempt 5 years ago to bully Applicant into a co-existence agreement – a discussion which is totally irrelevant to this Cross-Motion.

on the record at least by a counterstatement of facts set forth in detail in an affidavit by a knowledgeable affiant.” *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 940 16 USPQ2d 1783, 1786 (Fed. Cir. 1980), citing *Barmag Barmer Maschinenfabrik AG v. Murata Machinery, Ltd.*, 731 F.2d 831, 836 221 USPQ 561, 564 (Fed. Cir. 1984).

In this case, not only did Opposers fail to meet their burden, but the evidence which they supply reinforces the legal justification for the instant Cross-Motion:

- (1) Opposers re-submitted their Declaration admitting non-use of 13 goods listed in both of their registrations and outlining their 2 year pattern of reckless disregard as to the truth or falsity of their verifications.
- (2) Opposers submitted Declarations of their counsel and one Darrel Baum confirming non-use of skin care products save Opposers’ “Pre-Tweeze” and “After-Tweeze” products.
- (3) Opposers’ attempt to mislead the PTO with their 10 year old Exhibit displaying 16 makeup products and 2 skin care products (their “Tweeze” products) and no other product listed in their registrations puts a spotlight on Opposers’ continuing attempts to deceive the PTO.

All of the remaining irrelevant arguments and exhibits which Opposers have submitted are wholly improper and have no bearing on this Motion and the undisputed facts.

In deciding a motion for summary judgment, the evidence must be viewed in the light most favorable to the non-movant (*Olde TymeFoods Inc. v. Roundy’s Inc.*, 961 F. 2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992).

In this case, there is no light, natural or supernatural, in which the evidence can favor Opposers.



### **III. CONCLUSION**

Opposers' admitted (1) non-use of 13 goods; (2) false statements to the PTO; and (3) two year pattern of conduct of reckless disregard -- does violence to Section 1(a) of the Trademark Act and displays an attitude of contempt toward the legal process that is odious and indefensible.

Opposer's Disclosures consisting of her press interviews with "*The Wall Street Journal*" and "*Women's Wear Daily*" are "smoking guns" which Opposers cannot defend. In her own words, Opposer has made her rampant and reprehensible deceptive conduct with the PTO crystal clear.

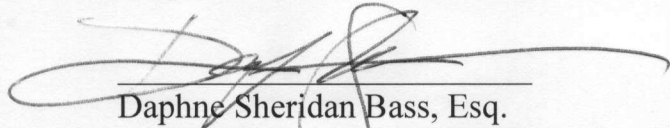
Giving credence to the excuses of a party who has made these admissions in the totality of this evidence is tantamount to nullifying the verification process. Its precedent would yield disastrous consequences. Truthful affiants believing in the system would always be at the risk of untruthful ones bent on gaming the system.

For all of the foregoing, Applicant respectfully requests that the Board:

- (1) dismiss Opposers' Motion to Dismiss as "moot" based upon Applicant's Motion to Amend and [Proposed] Amended Counterclaims of Fraud; and
- (2) grant this Cross-Motion canceling Registrations 2798069 and 2821892 in Class 3.

Dated: April 15, 2010

Respectfully submitted,



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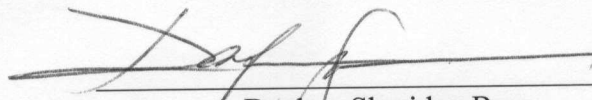


**CERTIFICATE OF SERVICE**

This is to certify that a true and correct copy of the foregoing **APPLICANT'S REPLY BRIEF TO OPPOSERS' OPPOSITION TO APPLICANT'S CROSS-MOTION FOR SUMMARY JUDGMENT** was served by email, by agreement, on John M. May, Esq., attorney for Opposers, at [jmay@berliner-ip.com](mailto:jmay@berliner-ip.com) and [John@May.us](mailto:John@May.us) this 15<sup>th</sup> day of April, 2010.

Date

April 15, 2010



Daphne Sheridan Bass

ANASTASIA BEVERLY HILLS, INC.  
ANASTASIA SOARE  
ANASTASIA SKIN CARE, INC.

V.

Opposition No.  
91188736

ANASTASIA MARIE LABORATORIES, INC.

Applicant.

Applicant, by its attorney, hereby moves, pursuant to Trademark Rule 2.107, to amend its Counterclaims to plead fraud with particularity in accordance with *DaimlerChrysler Corporation and Chrysler, LLC v. American Motors Corporation*, Cancellation No. 92045099 (January 14, 2010).

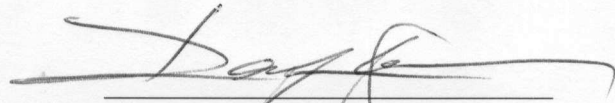
In support of this motion, Applicant asserts that it has filed Counterclaims to cancel Opposers' pleaded Registrations Nos. 2,798,069 and 2,821,892 on the basis of fraud. On January 14, 2010, Opposers filed a Motion to Dismiss a Motion to Amend the foregoing registrations to delete the following 13 goods which Opposers state have not been used in Class 3: nail polish, nail base coat, nail top coat, body powder, facial toners, facial astringents, facial masques, body toners, body astringents, body cleansing gels, fragranced gels, bar body toners and astringents.

Opposers' admissions and claimed excuses for their misrepresentations reveal that Opposers committed fraud upon the Patent and Trademark Office in obtaining registrations for the goods identified in both of their registrations which included nail polish, nail base coat, nail top coat, body powder, facial toners, facial astringents, facial masques, body toners, body astringents, body cleansing gels, fragranced gels, bar body toners and astringents.

In view of the foregoing, and because this motion is filed promptly after Opposers' filing of their Motion to Amend, it is submitted that the motion is well taken and that the Amended Counterclaims submitted herewith should be accepted and substituted for the Counterclaims.

Respectfully submitted,

DATED: April 15, 2010



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Anastasia Marie Laboratories, Inc.



**CERTIFICATE OF SERVICE**

This is to certify that a true and correct copy of the foregoing **APPLICANT'S MOTION TO AMEND COUNTERCLAIMS** was served by email, by agreement, on John M. May, Esq., attorney for Opposers, at jmay@berliner-ip.com and John@May.us this 15<sup>th</sup> day of April, 2010.

Date

April 15, 2010

Daphne Sheridan Bass

Daphne Sheridan Bass

ANASTASIA BEVERLY HILLS, INC.	)	
ANASTASIA SOARE	)	
ANASTASIA SKIN CARE, INC.	)	
	)	
Opposers,	)	Opposition No.
	)	91188736
v.	)	
	)	
ASTASIA MARIE LABORATORIES, INC.	)	<b>APPLICANT'S</b>
	)	<b>[PROPOSED]</b>
	)	<b>AMENDED</b>
	)	<b>COUNTERCLAIMS</b>
	)	<b>FOR</b>
Applicant / Petitioner.	)	<b><u>CANCELLATION</u></b>
	)	

## FRAUD

Potpourri; cosmetics, namely, foundation, concealer, pressed powder, loose powder, eye shadow base, blush, bronzing liquid, eye shadows, mascara, eyeliners, lip coverings, lipstick, lip gloss, lip liners, eyebrow color pencils, eyebrow pencils, eyebrow powder, eyebrow pomade, eyebrow gel, nail polish, nail base coat, and nail top coat; skin care products, namely, facial cleansers, facial cleansing bars, facial toners, facial astringents, facial moisturizers, eye creams, eye gels, eye-area moisturizers, eye-area gels, eye-area creams, facial masques, facial

serums, facial exfoliators, body cream, body lotion, body powder, body moisturizers, body lotions, body toners, body astringents, and hand creams; body cleansing products, namely, creams, gels, and bar soaps; fragrance products, namely, perfume, eau de parfum, eau de toilette, eau de cologne, fragranced creams, lotions, gels, bar body toners, and astringents; room fragrances in Class 3, candles in Class 4, eyebrow tweezers, eyebrow grooming scissors in Class 8 and cosmetic brushes in Class 21.

2. Opposers' Registration No. 2,798,069 issued from Opposers' Application Serial No. 75833290 filed with the U.S. Patent and Trademark Office ("PTO") on October 27, 1999 on an intent-to-use basis.

3. On June 3, 2003, the PTO issued a Notice of Allowance on Application Serial No. 75833290 for the following goods in Class 3:

Potpourri; cosmetics, namely, foundation, concealer, pressed powder, loose powder, eye shadow base, blush, bronzing products, eye shadows, mascara, eyeliners, lip coverings, lipstick, lip gloss, lip liners, eyebrow color products, eyebrow pencils, eyebrow powder, eyebrow pomade, eyebrow gel, nail polish, nail base coat, and nail top coat; skin care products, namely, facial cleansers, facial cleansing bars, facial toners, facial astringents, facial moisturizers, eye creams, eye gels, eye-area moisturizers, eye-area gels, eye-area creams, facial masques, facial serums, facial exfoliators, body cream, body lotion, body powder, body moisturizers, body lotions, body toners, body astringents, and hand creams; body cleansing products, namely, creams, gels, and bar soaps; fragrance products, namely, perfume, eau de parfum, eau de toilette, eau de cologne, fragranced creams, lotions, gels, bar body toners, and astringents; room fragrances in Class 3, candles in Class 4, eyebrow tweezers, eyebrow grooming scissors in Class 8 and cosmetic brushes in Class 21.



4. On August 5, 2003, Opposers submitted an undated Declaration that the mark A ANASTASIA BEVERLY HILLS was used in commerce on or in connection with the goods specified in the Notice of Allowance and a Statement of Use claiming September, 1999 as the date of first use of the goods in commerce. Opposers made these representations to the PTO to induce the PTO to issue a registration.

5. As of January 14, 2010, years after Opposers had represented to the PTO that they used the A ANASTASIA BEVERLY HILLS mark in commerce in connection with nail polish, nail base coat, nail top coat, body powder, facial toners, facial astringents, facial masques, body toners, body astringents, body cleansing gels, fragranced gels, bar body toners, astringents, Opposers, in fact, had had not used the foregoing goods in commerce under the A ANASTASIA BEVERLY HILLS mark.

6. In a Motion to Amend filed on January 14, 2010 with the Trademark Trial and Appeal Board (the "Board"), Opposers explicitly admitted that they had not used in commerce the A ANASTASIA BEVERLY HILLS & Design mark which is the subject of Registration No. 2,798,069 on any of the following 13 specifically listed goods: nail polish, nail base coat, nail top coat, body powder, facial toners, facial astringents, facial masques, body toners, body astringents, body cleansing gels, fragranced gels, bar body toners, astringents.

7. Opposers' representations to the PTO on August 8, 2003 were false.

8. Opposers knew that the representations were false and made those representations with the intent to deceive the PTO.

9. Opposers knowingly made material representations to the PTO to procure Registration No. 2,798,069.

10. The PTO relied upon Opposers' representations in issuing Registration No. 2,798,069.

11. Opposers' misrepresentations were material, because the PTO would not have issued Registration No. 2,798,069 but for Opposers' false representations.

12. Opposers' actions in the procurement of Registration No. 2,798,069 constitute fraud; thereby invalidating Registration No. 2,798,069. Accordingly, Registration No. 2,798,069 should be invalidated in Class 3.

13. Petitioner timely filed its counterclaim for cancellation, and this cancellation proceeding was instituted on March 16, 2009.

WHEREFORE, Petitioner respectfully requests that this Counterclaim for Cancellation be granted, and that Registration No. 2,798,069 be cancelled in Class 3.

### **CANCELLATION OF REGISTRATION NO. 2,821,892**

#### **FRAUD**

14. Opposers own Registration No. 2,821,892 for the mark ANASTASIA BEVERLY HILLS for the following goods in Class 3:

Potpourri; cosmetics, namely, foundation, concealer, pressed powder, loose powder, eye shadow base, blush, bronzing liquid, eye shadows, mascara, eyeliners, lip coverings, lipstick, lip gloss, lip liners, eyebrow color pencils, eyebrow pencils, eyebrow powder, eyebrow pomade, eyebrow gel, nail polish, nail base coat, and nail top coat; skin care products, namely, facial cleansers, facial cleansing bars, facial toners, facial astringents, facial moisturizers, eye creams, eye gels, eye-area moisturizers, eye-area gels, eye-area creams, facial masques, facial



serums, facial exfoliators, body cream, body lotion, body powder, body moisturizers, body lotions, body toners, body astringents, and hand creams; body cleansing products, namely, creams, gels, and bar soaps; fragrance products, namely, perfume, eau de parfum, eau de toilette, eau de cologne, fragranced creams, lotions, gels, bar body toners, and astringents; room fragrances in Class 3, candles in Class 4, eyebrow tweezers, eyebrow grooming scissors in Class 8 and cosmetic brushes in Class 21.

15. Opposers' Registration No. 2,821,892 issued from Opposers' Application Serial No. 75833810 filed with the PTO on October 28, 1999 on an intent-to-use basis.

16. On May 22, 2001, Opposers signed a Declaration which was submitted to the PTO with an Amendment to Allege Use dated June 19, 2001 alleging that the mark ANASTASIA BEVERLY HILLS was used in commerce on or in connection with the goods specified in Application Serial No. 75833810 claiming September, 2000 as the date of first use of the goods in commerce. Opposers made these representations to the PTO to induce the PTO to issue a registration.

17. As of January 14, 2010, years after Opposers had represented to the PTO that they had used the ANASTASIA BEVERLY HILLS mark in commerce in connection with nail polish, nail base coat, nail top coat, body powder, facial toners, facial astringents, facial masques, body toners, body astringents, body cleansing gels, fragranced gels, bar body toners, astringents, Opposers, in fact, had not used the foregoing goods in commerce under the ANASTASIA BEVERLY HILLS mark.

17. In a Motion to Amend filed on January 14, 2010 with the Trademark Trial and Appeal Board (the "Board"), Opposers explicitly admitted that they had not used in commerce the ANASTASIA BEVERLY HILLS & Design mark which is the subject of Registration No. 2, 821,892 on any of the following 13



specifically listed goods: nail polish, nail base coat, nail top coat, body powder, facial toners, facial astringents, facial masques, body toners, body astringents, body cleansing gels, fragranced gels, bar body toners, astringents.

18. The representations which Opposers made to the PTO on May 22, 2001 were false.

19. Opposers knew that the representations were false and made those representations with the intent to deceive the PTO.

20. Opposers knowingly made material representations to the PTO to procure Registration No. 2,821,892.

21. The PTO relied upon Opposers' representations in issuing Registration No. 2,821,892.

22. Opposers' misrepresentations were material, because the PTO would not have issued Registration No. 2,821,892 but for Opposers' false representations.

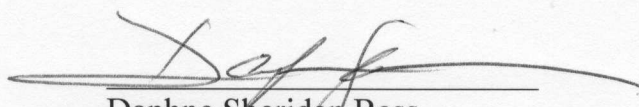
23. Opposers' actions in the procurement of Registration No. 2,821,892 constitute fraud; thereby invalidating Registration No. 2,821,892.

24. Petitioner timely filed its counterclaim for cancellation, and this cancellation proceeding was instituted on March 16, 2009.

WHEREFORE, Petitioner respectfully requests that this Counterclaim for Cancellation be granted, and that Registration No. 2,821,892 be cancelled in Class 3.

Dated:

April 15, 2010

  
Daphne Sheridan Bass

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Attorney for Applicant

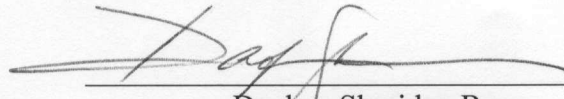
Anastasia Marie Laboratories, Inc.

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